

REMARKS

Claims 1 and 26-37 were pending in the above-captioned patent application prior to this amendment. Claims 2-25 were canceled previously. Claims 27 and 32 are canceled herein. Claims 1 and 26 are amended herein. Thus, after this amendment, claims 1, 26, 28-31, and 33-37 are pending in the application.

The examiner objected to the drawings under 37 C.F.R. § 1.83(a) as not showing the additional expansion zipper and the internal stiffening member which the examiner contends is recited in claims 27 and 32. Claims 27 and 32 are canceled herein thereby overcoming this objection. Accordingly, withdrawal of the objection to the drawings is respectfully requested.

The examiner refused to accept the declaration under 37 C.F.R. 1.131 and pointed out several supposed deficiencies. The examiner states at the top of Page 3 of the October 29, 2008 Office Action that “[i]n response to this office action, applicant is required to point out exactly what limitations in each of the claims are covered by the evidence shown in the declaration under 37 CFR 1.131 and detailing the corresponding support in the evidence.” The examiner goes on to state, “[a]pplicant is also need to correct said paragraphs 3, 5-6 to provide the correct information detailing certain claims are being invention with two separate priorities covering two separate embodiments and what features are covered by the evidence.” A new declaration under 37 C.F.R. 1.131 is submitted herewith to address the examiner’s concerns. The declaration under 37 C.F.R. 1.131 relates to the patentability of claim 1 and claim charts are provided in the declaration under 37 C.F.R. 1.131 showing where in the Exhibit documents support for the claim 1 language can be found. Once an independent claim is determined to be patentable, all claims dependent thereon are also patentable absent any formalities problems such as, for example, antecedent basis or typographical errors. However, the examiner’s comment that the wheel structure is not supported by the presented evidence is not correct. Page 3 of Exhibit A of the Declaration shows the “Corner Wheels.” As to the examiner’s confusion as to the priority date being relied upon in the declaration under 37 C.F.R. 1.131, please note that it is the conception date of the invention as evidenced by Exhibit A of the declaration under 37 C.F.R. 1.131 being prior to the filing date of the Hsieh reference that is relied upon to “swear

behind” the Hsieh reference. Exhibit B is provided to show a diligent reduction to practice of the invention after conception. The fact that conception occurred prior to Hsieh’s filing date and the fact that there was diligent reduction to practice thereafter is all that is needed to remove Hsieh as a reference.

Further with regard to the examiner’s comments regarding the present application having priority claims to two different applications, Applicant is relying only on British Patent Application No. 0324487.8, (i.e., the priority application having the earlier of the two priority dates) for its effect as a constructive reduction to practice of the invention which, coupled with the conception date prior to the filing date of the Hsieh reference, antedates the Hsieh reference. The priority application being relied upon by Applicant has digital photos as some of its Figures of an actual reduction to practice of the invention claimed in claim 1 of the present application. However, certain recitations in claim 1 cannot be seen in those digital photos, but can be seen in other Figures, which is why British Patent Application No. 0324487.8 is being relied upon as a constructive reduction to practice, not an actual reduction to practice. Because the examiner has specifically requested a new declaration under 37 C.F.R. 1.131, the undersigned trusts that there will be no problem with its entry into the record at this stage of prosecution.

The examiner rejected claims 1 and 26-37 under 35 U.S.C. 112, second paragraph as being indefinite. Specifically, the examiner states, “[t]he claim set forth the limitations that there is no internal/external perimeter framing and reinforcing side, base and back panels” and then the examiner notes, “. . . that there are supporting panels 25, and 18 that are required to support the luggage wheels and handles.” Claim 1 has been amended to clarify that the lid and base forming sections “are both shape wise maintaining in the absence of any internal/external perimeter framing around the entire periphery of the lid and base forming sections and are shape wise maintaining in the absence of any reinforcing side, base and back panels so that the soft suitcase is not of box construction” With regard to the term “box construction,” it is a term of art in the luggage industry and is intended to have the meaning discussed in the paragraph at page 4, lines 3-8 of the application as filed. The elements 18 and 25 shown in the Figures of the present application are not reinforcing boards of the type that would lead one skilled in the art to consider the claimed suitcase of the box construction type. Accordingly, now that claim 1 has

been clarified, withdrawal of the rejection under 35 U.S.C. 112, second paragraph as being indefinite is respectfully requested. Of course, since claims 27 and 32 have been canceled herein, the indefiniteness rejection of those claims is rendered moot.

The examiner rejected claims 1, 26, 31, 32 and 34-37 under 35 U.S.C. § 103(a) as being unpatentable over Nykoluk (U.S. Pat. No. 6,062,356) in view of Lee (U.S. Pat. No. 5,284,542) or Chang (U.S. Pat. App. Pub. No. 20040101669). The examiner states that “Nykoluk ‘874 meets all claimed limitations except for the material being molded foamed plastic” and that “[i]t would have been obvious to one of ordinary skill in the art to make the case from foamed plastic material as taught by Lee or Chang to provide the desired material for the case.” The undersigned respectfully disagrees with the examiner’s statement that “Nykoluk ‘874 meets all claimed limitations except for the material being molded foamed plastic.” Nykoluk teaches and discloses a **framed** case of the type that is explicitly excluded by the plain language of claim 1. The very first sentence of Nykoluk states, at col. 1, lines 7 and 8, that Nykoluk’s “... invention pertains generally to bags and, more particularly, to **framed** cases with feet.” Nykoluk teaches, at col. 2, lines 30-32, “[a]n internal frame 33 made from a substantially rigid material such as plastic **extends around outer periphery** 26 to provide support for body 17.” In contrast, claim 1 has been clarified to state that “both the lid and base forming sections are moulded as one-piece tray like forms and are both shape wise maintaining such that **the soft suitcase has no internal/external perimeter framing around the entire periphery of the lid and base forming sections . . .**” (Emphasis added)

Furthermore, Nykoluk teaches the following at col. 2, lines 29-41:

An internal frame member or frame 33 made from a substantially rigid material such as plastic extends around outer periphery 26 to provide support for body 17. **Frame 33, a portion of which is shown in FIG. 7, has the shape of an endless rectangular member and is formed from four strip portions or planar strips 34 extending respectively through the four walls 21-24 of outer periphery 26 at right angles to each other.** Frame 33 has a squared forward edge 35 and a constant thickness and a constant width. A flexible web means in the form of outer layer or cover 36 extends around body 17. Cover 36 is made from any suitable

durable material such as ballistic nylon and has at least one rolled seam 37 therein. (Emphasis added)

It is quite clear, therefore, that Nykoluk's suitcase is of the "box construction" type that is explicitly excluded from being within the scope of claim 1 of the present application.

The examiner relies on Lee and Chang in the alternative as teaching foamed plastics material. However, neither Lee nor Chang teach a soft suitcase in which "**both** the lid and base forming sections are moulded as one-piece tray like forms" which "comprise foamed plastics material" as recited in claim 1 of the present application. Lee teaches that only his cover (the portion of Lee that would arguably correspond to the recited "lid forming section" of claim 1) is made of foamed plastics material. Lee is silent as to the construction of Lee's base section and Lee doesn't even have a reference numeral corresponding to Lee's base section. Thus, Lee does not teach the construction of both the lid and base forming sections of a soft suitcase from the same process. Chang teaches only the use of a flat board, not a tray like form, as the cover or lid of the suitcase shown in Fig. 1. Thus, claim 1 patentably distinguishes over Nykoluk in combination with Lee or Chang. For at least these reasons, claim 1 along with claims 26, 28-31, and 33-37 that depend either directly or indirectly from claim 1 are in condition for allowance and such action is respectfully requested.

The examiner rejected claims 1, 26, 29, 30, 31, 32, 34 and 35 "under 35 U.S.C. § 103(a) as being unpatentable over Hsieh (U.S. Pat. App. Pub. No. 2005/0056511) in view of Nykoluk (U.S. Pat. No. 6,062,356), and further in view of Lee (U.S. Pat. No. 5,284,542). Submitted herewith is a Declaration Under 37 C.F.R. § 1.131 to antedate or swear behind the Hsieh reference. See the discussion above regarding how this new Declaration Under 37 C.F.R. § 1.131 has overcome the examiner's concerns. The fact of the matter is that the inventor of the present application conceived the subject matter recited in claim 1 of the present application, prior to the September 16, 2003 filing date of Hsieh and the invention was constructively reduced the invention to practice diligently via the filing of British Patent Application No. 0324487.8 on October 21, 2003. This inventive activity took place in a WTO member country and therefore, 35 U.S.C. § 104 is applicable. Accordingly, because Hsieh cannot be used as a reference to reject the present application and because claim 1 distinguishes over the Nykoluk

and Lee references (i.e., the other two references being combined with Hsieh to reject claim 1 in this particular obviousness rejection) as discussed above, withdrawal of the rejection of claims 1, 26, 29, 30, 31, 32, 34 and 35 based on the combination of Hsieh, Nykoluk, and Lee is respectfully requested. Of course, claim 32 has been canceled and so the rejection of that claim based on the combination of Hsieh, Nykoluk, and Lee is rendered moot.

The examiner rejected claims 1, 26, 29, 30, 31, 32, 34 and 35 under 35 U.S.C. § 103(a) as being unpatentable over Van Him Beek (*sic*) (U.S. Des. Pat. No. D492,110) in view of either Chang or Lee and, further in view of Nykoluk. Van Himbeek is a design patent showing only the exterior of a suitcase. Accordingly, there is no teaching in Van Himbeek of a soft suitcase having “both the lid and base forming sections . . . moulded as one-piece tray like forms” that “are both shape wise maintaining such that the soft suitcase has no internal/external perimeter framing around the entire periphery of the lid and base forming sections and has no reinforcing side, base and back panels so that the soft suitcase is not of box construction . . .” as recited in claim 1 of the present application. The deficiencies of Nykoluk, Chang and Lee are discussed above. Accordingly, withdrawal of the rejection of claims 1, 26, 29, 30, 31, 32, 34 and 35 under 35 U.S.C. § 103(a) as being unpatentable over Van Himbeek in view of Chang or Lee and, further in view of Nykoluk is respectfully requested. Of course, since claim 32 has been canceled herein, the rejection of that claim based on the combination of Van Himbeek, Lee or Chang, and Nykoluk is rendered moot.

The examiner made several rejections under 35 U.S.C. § 103(a) in paragraphs 5-7 of the October 29, 2008 Office Action to reject dependent claims 27 and 33 (paragraph 5), claim 28 (paragraph 6), and claim 36 (paragraph 7). The examiner also made several rejections under 35 U.S.C. § 103(a) in paragraphs 9-11 of the October 29, 2008 Office Action to reject dependent claims 27 and 33 (paragraph 9), claim 28 (paragraph 10), and claims 36 and 37 (paragraph 11). Finally, the examiner made several rejections under 35 U.S.C. § 103(a) in paragraphs 13-15 of the October 29, 2008 Office Action to reject dependent claims 27 and 33 (paragraph 13), claim 28 (paragraph 14), and claims 36 and 37 (paragraph 15). However, because claim 1 of the present application is in condition for allowance as discussed above, these various rejections of

dependent claims 27, 28, 33, 36 and 37 are rendered moot. Of course, claim 27 has been canceled herein as noted multiple times already.

Based on the foregoing, claim 1 along with dependent claims 26, 28-31, and 33-37 are in condition for allowance and such action is respectfully requested. The amendment to claim 26 made herein was simply to change "Zip" to "zip" for one of the occurrences in claim 26 that was inadvertently missed when responding to the previous Office Action. Also, paragraph 17 of the October 29, 2008 Office Action seems to have stock language pertaining to final Office Actions as it discusses receipt of an Advisory Action if a response is filed within two months of the Office Action date. However, the Office Action of October 29, 2008 was not a final Office Action as is noted on the Office Action Summary sheet. Because of the RCE filed electronically August 29, 2008, the October 29, 2008 Office Action should properly be a non-final Office Action.

It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response and that shortages in fees, if any, be charged to the Account of Barnes & Thornburg, Deposit Account No. 10-0435, with reference to our file 38566-79926.

Respectfully submitted,
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